Attorney Docket # 33901-188PUS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Arnaud BRUN et al.

Serial No.: 10/563,937

Filed: January 9, 2006

For: Method and System for Transmission of Vocal Content by MMS

Examiner: Elahee, MD S

Group Art: 2614

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

Applicants request review of the Final Rejection in the above-referenced application. No amendments are being filed with this request.

The review is requested for the reasons set forth on the following pages.

REMARKS

Independent claim 12 stands rejected under 35 U.S. C. §102(e) as anticipated by U.S. Publication No. 2002/0172331 ("*Barker*"). Independent claim 1 stands rejected under 35 U.S.C. §103(a) as unpatentable over *Barker* in view of U.S. Publication No. 2003/0169865 ("*Oren*"). For the following reasons, Applicants respectfully assert that all claims of the present application are patentable over the cited reference.

Independent claim 1 recites the limitation "wherein said producing of the sound content at the first telephone terminal precedes and is temporally separate from said sending of the sound content by the first telephone terminal, said sound content being included in a message as an element of the message; and wherein said producing of the sound content is performed without requiring connection of the first telephone terminal to a remote device". Independent claim 12 recites the limitation "said sound content being previously produced at the telephone terminal without requiring connection of the telephone terminal to a remote telecommunications device, and wherein said storage entity extracts the sound content contained in the message". That is, independent claims 1 and 12 respectively define a method and a device for producing sound content, such as an audio element, at a telephone terminal without requiring connection of the telephone terminal to a distant, remote device.

The Examiner (in *Response to Arguments* at pgs. 2-3 of the Final Office Action) asserts that:

> In page 2, paragraph 0023, page 5, paragraph 0082, Barker discloses that the sender can dictate the message by speaking into a microphone and after completing the message, the message is transmitted to a playback server [i.e., storage entity]. It clearly means that the sound being previously produced at the sender's terminal without requiring connection of the telephone terminal to a remote telecommunications device. The sender types in the message the desired date and time for delivery of the message (see page 5, paragraph 0079. When the delivery time comes, the server sends the audio message to the recipient. It clearly means that the server extract the sound content from the message. In other word, the storage entity extracts the sound content contained in the message.

Applicants do not agree and believe that Examiners assertions are based on a factual deficiency. As will be described below, *Barker* does <u>not</u> disclose "producing of the sound

content is performed without requiring connection of the first telephone terminal to a remote device", because *Barker* avoids problems associated with limited storage capacity of telephones.

Barker (paragraph [0008], lines 1-8) describes a telephone message delivering system which allows a sender to select a pre-recorded track from a menu, to be replayed to the recipient over the telephone lines.

Barker (paragraph [0023]) teaches that the disclosed system and method allows a user of a telephone terminal to send to a recipient a message that includes pre-recorded sounds elements, such as music tracks or Christmas greetings, without having to record these elements on his or her telephone; the message is stored on a server and the sender of the sound message is given access to those <u>server-stored</u> sound elements via a simple list on a menu. Thus, the sound elements are not input to or recorded on the telephone; they reside <u>exclusively</u> on the server, and are selected for inclusion in a message through a simple text "pick list" that the user can access on the telephone. Moreover, throughout the entire *Barker* publication, there is <u>no</u> teaching or suggestion that the user can compose a message without being connected to the server from which the message is eventually sent. That is, even assuming, *arguendo*, that *Barker* teaches that a pre-recorded message can be personalized with other elements (i.e., with sound or a written message) by speaking into a microphone (or typing at a computer), and that the complementary sound is composed from the terminal, *Barker* in fact teaches <u>only</u> that the composed sound message is <u>always directly recorded on the server</u> from which the message is eventually sent. Applicants thus dispute the Examiner's proffered analysis of *Barker*.

Barker (paragraph [0076]) clearly explains that the sender of the message dictates the text of their message by speaking after a cue, such as a tone, i.e., the terminal of the sender functions as a microphone. The dictated text is then recorded by a processor unit 141 of the call compilation system 140, which is <u>not</u> part of the telephone but, instead, part of a remote server. This process of *Barker* can <u>only</u> occur while the telephone (or the user's personal computer) is connected to the server.

Barker is replete with statements consistent <u>only</u> with the above interpretation of its teachings. For example, *Barker* (paragraph [0058], lines 4-6) explains that "[t]he sender's telephone is <u>connected</u> to the public switch telephone network or PSTN (130)". *Barker* (paragraph [0070], lines 3-6) additionally explains that "the sender will use their telephone 100. The sender will telephone the system 140 using either a premium rate line 110 or a normal rate

line 11". *Barker* thus clearly teaches that the user of the telephone composes sound content while underlined connected to the call compilation system 140 via a telephone link. *Barker* (paragraph [0079], lines 1-4) further explains that "[i]n order to initiate the process the sender will send a request for instructions via their personal computer 200, over a premium rate line 210 or normal rate line 211, via the internet 230 to the server 240". *Barker* thus teaches that in instances where the sender utilizes a computer instead of a telephone terminal, dictation of text is also performed while the computer terminal of the user is underlined connected to a server on which the sound content dictated by the user is directly recorded.

Barker accordingly teaches two embodiments in which sound content is placed, i.e., recorded, on a server. That is, *Barker* teaches two different ways to record sound content dictated by a user directly on a remote device, both of which are consistent with its described objects, i.e., avoiding the storage of messages underlined on the terminal prior to sending the message to a recipient.

Barker (paragraph [0083], lines 2-8) provides still additional teachings that evidence and support the fact of connection of the telephone/terminal to the remote server while a user dictates a message. *Barker* (paragraph [0083], lines 2-8) states that "the sender will contact the system underlined by telephoning or logging on to the call compilation server 240 via a premium rate line.... As soon as underlined connection is made to the compilation server 140 or 240, a timer ... will commence timing the duration of the call". *Barker* (paragraph [0083], lines 10-22) also explains that "[a]ll the time that the call compilation procedure is being executed, the processor will continue to time the sender's call ... the processor will compute the time required for the sender to underlined remain underlined connected via the premium rate line to the compilation server 140 or 240". Such continuous connections and tariff charging for connection times is contrary to and underlined defeats the central purpose of the claimed invention, i.e., avoiding charges associated with call connections.

Barker thus clearly teaches a system and method that is in direct opposition to applicants' invention as recited in independent claims 1 and 12; the claimed invention permits the composition of sound content without the need to connect the input telephone or personal computer to a remote device, such as a telecommunications network. *Barker* clearly teaches a system and method in which a sender, underlined when connected to a server, composes a message with sound content that is underlined directly recorded on the server. *Barker* simply fails to teach or suggest the recited subject matter of independent claims 1 and 12.

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Moreover, even assuming, *arguendo*, that the server of the *Barker* system is capable of receiving information relating to the sending of the message (i.e., the telephone number of the recipient, the date and hour for delivery), this information is <u>not</u> extracted from the message itself but is, instead recorded independently – in sequential order, one after the other – and directly on the remote system 140 or server 240, as described in steps S7 to S9, S29 to S31 in FIGS. 9 and 10 of *Barker*.

The instant claimed invention differs from the teachings of *Barker* in that the produced sound is only included in a message when sound content including the message is sent. As a result, a telephone terminal is only required to access the telephone network for a short period of time to effect actual transmission of the previously produced sound content. *Barker* fails to teach or suggest applicants' claimed invention that encompasses these advantageous features and functionality.

Reconsideration and withdrawal of the rejection of independent claim 12 as anticipated by *Barker* under 35 U.S.C. §102 are accordingly deemed to be in order, and early notice to that effect is solicited.

In the rejection of independent claim 1, the Examiner (at pg. 6 of the Final Office Action) acknowledges that *Barker* fails to teach or suggest "storing said sound content with a view to subsequent consultation by a second telephone terminal," as recited in independent claim 1, and cites *Oren* for this feature.

Applicants, however, contend that no combination of *Barker* and *Oren* achieves the subject matter of independent claim 1. There is simply nothing in *Oren* to cure the above-discussed deficiencies in *Barker*, e.g., the lack of teachings relating to applicants' claimed producing of the sound content that is performed without requiring connection of the telephone terminal to a remote/telecommunications device.

Oren discloses "a method, apparatus and system of completing a call when a called party has not answered the call from a calling party" (see Abstract). *Oren* (paragraph [0005], lines) explains that an interaction between the parties is completed, rather than simply the completion of a voice call. *Oren* (paragraph [0005], lines 9-12) further explains that "a network operator's central office may reallocate 'circuit switching' and voice channels for other context, while reducing real-time voice interaction constraints within the network". *Oren* (paragraph [0005],

lines 12-14) additionally explains that "messaging content generated by the present invention is transmitted in less expensive 'data circuit' channels, such as the Internet".
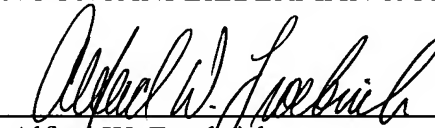
There is nothing in *Oren* to cure the above-discussed deficiency in *Barker*, e.g., the lack of teachings relating to applicants' claimed producing of the sound content that is performed without requiring connection of the telephone terminal to a remote/telecommunications device.

In view of the foregoing, independent claim 1 is deemed to be patentable over the combination of *Barker* and *Oren*. Reconsideration and withdrawal of the rejection under 35 U.S.C. §103(a) are requested, and early notice to that effect is earnestly solicited.

Applicant respectfully submits that this application is in condition for allowance, and such action is respectfully requested.

Respectfully submitted,
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